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OFFICE OF PETITIONS

In re Patent of Huffman et al.	:	
Patent No. 7,505,936	:	DECISION ON APPLICATION
Issue Date: March 17, 2009	:	FOR RECONSIDERATION OF
Application No. 09/940,276	:	PATENT TERM ADJUSTMENT
Filing Date: August 27, 2001	:	
Attorney Docket No. 12587-0010001	:	

This is in response to the "Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(d)" filed May 12, 2009. Patentees request the determination of patent term adjustment indicated on the patent be corrected from one thousand six hundred nineteen (1,619) days to two thousand one hundred sixty-nine (2,169) days.

The request for reconsideration of the patent term adjustment indicated on the patent is **granted to the extent indicated herein**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand four hundred and ninety-nine (1,499) days.

Any response to this decision must be submitted within the longer of ONE (1) MONTH or THIRTY (30) DAYS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted. Any response should include a cover letter entitled "Renewed Request under 37 CFR 1.705(d)."

The application was filed August 27, 2001. The application matured into United States Patent No. 7,505,936 with a revised patent term adjustment of 1,619 days on March 17, 2009. This request for reconsideration was timely filed within two months of the issue date of the patent.

Patentees assert the correct patent term adjustment is 2,169 days which is the sum of 1,612 days of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") and 1,663 days of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") reduced by 942 days of overlap and 164 days of Applicant Delay.

The amount of A Delay (1,612 days) and the amount of B Delay (1,663 days) are not in dispute. The amount of overlap and the amount of Applicant Delay are in dispute.

35 U.S.C. § 154(b)(2)(A) limits Office delay to the sum of A Delay and B Delay to the extent such periods of delay are not overlapping. Specifically, 35 U.S.C. § 154(b)(2)(A) states,

To the extent that time periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Patentees assert the period of overlap is 942 days. The Office contends the period of overlap is 1,612 days.

The Office has described its position regarding the proper interpretation of 35 U.S.C. § 154(b)(2)(A) as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment.¹

In this case, the relevant time period when determining if periods of delay “overlap” is the time period from the filing date of the application, August 27, 2001, to the date of issuance of the patent, March 17, 2009.²

The period of delay of 1,663 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 1,430 days for Office delay pursuant to 37 C.F.R. § 1.702(a)(1) and with the adjustment of 182 days for Office delay pursuant to 37 C.F.R. § 1.702(a)(4).

¹ *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004) (quoting *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704, 21706 (April 22, 2004)). The Notice also provided a discussion of an example of the application of the overlap provision:

A two month delay in issuing a first Office action (35 U.S.C. 154(b)(1)(A)(i)) and a two-month delay in issuing the patent (35 U.S.C. 154(b)(1)(B)) [are] considered overlapping delays, even though the two-month delay in issuing the first Office action occurred prior to three years (thirty-six months) after the application's filing date. This is because if the Office does not issue the patent until three years and two months (thirty-eight months) after its filing date, the relevant period in determining the Office delay in issuing the patent is not just the period between three years (thirty-six months) after the application's filing date and the date the patent issues (thirty-eight months after the application's filing date), but is the entire period between the application's filing date and the date the application issues.

² The instant case does not contain any time periods falling under 35 U.S.C. §§ 154(b)(1)(B)(i)-(iii).

Since the 1,663 days of B delay overlap with a total of 1,612 days (1,430 days + 182 days) of A Delay, the Office acted properly when the Office increased the patent term by 51 days (1,663 days reduced by 1,612 days) for B Delay when issuing the patent.

The Office mailed a Notice of Allowance on March 5, 2008. On March 17, 2008, patentees filed a "Request for Initialed Forms PTO 1449" ("Request") on March 17, 2008, which stated,

Applicants have not received initialed copies of the Forms PTO 1449 that accompanied the Information Disclosures dated November 27, 2002; January 30, 2003; March 26, 2003; May 17, 2004; July 13, 2005; December 12, 2005; March 9, 2006; and August 18, 2006. A copy of each of these forms is enclosed for the Examiner's convenience.

The file contains a copy of the initialed 1449 forms. The examiner's signature on the forms is dated April 21, 2008. The record appears to indicate a copy of the initialed forms *may* have been mailed to patentees on April 29, 2008.

When calculating the patent term adjustment that appeared on the patent, the Office did not enter any reduction of patent term adjustment for the Request filed March 17, 2008.

In good faith and candor, patentees assert the amount of Applicant Delay should have been increased by 120 days due to the filing of the paper on March 17, 2008.

37 CFR 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

The Office agrees with patentees that a 120-day reduction in patent term adjustment is appropriate as a result of the March 17, 2008 Request. Specifically, the March 17, 2008 paper should have resulted in a reduction of 120 days in patent term adjustment pursuant to 37 C.F.R. § 1.704(c)(10).

The Office has entered a reduction of 120 days in patent term adjustment.

Conclusion

The Office acted properly when it increased the patent term adjustment 51 days for B Delay.

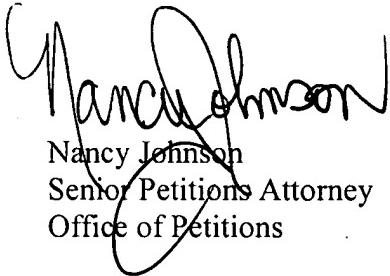
The Office has entered a reduction of 120 days in patent term adjustment pursuant to 37 C.F.R. § 1.704(c)(10).

The patent term adjustment, as revised by the instant decision, is 1,499 days.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand four hundred ninety-nine (**1,499**) days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,505,936 B2
ISSUE DATE : March 17, 2009 DRAFT
INVENTOR(S) : Huffman et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1619 days.

Delete the phrase "by 1619 days" and insert - by 1499 days--